

### **REMARKS**

In view of the above amendments and following remarks, reconsideration of the objections and rejections contained in the Office Action of April 10, 2008 is respectfully requested.

#### **Formal Matters**

The abstract has been amended to be fewer than 150 words.

The Examiner's objections to the claims have been addressed by making the changes requested by the Examiner.

The Examiner's rejections of the claims under 35 USC 112, 2<sup>nd</sup> paragraph have been addressed by only referring to the moving direction of the punches, thus deleting reference to "vertical." Reference to the "cam plate" has been replaced with reference to the "reciprocating member." A further reference to the punching state has been included in the claim for the first group of punches.

However, there is antecedent basis for the punching and non-punching positions contained at line 8 of the claim, so this language has not been changed.

As such, it is respectfully submitted that all of the formal issues raised by the Examiner have been addressed and overcome.

#### **The Office has Failed to Present a Prima Facie Case of Obviousness**

In the Office Action, claims 15 and 20-24 were rejected as being unpatentable over Fukumoto et al., US Pat. Pub. No. 2001/0011492 (Fukumoto), the same reference as previously cited (and which corresponds to the prior art discussed in the background of the specification). The Examiner's basic position is that while Fukumoto does not disclose applicant's invention of having the second group of punches include one of the punches of the first group, the Examiner nonetheless considers this obvious without any additional evidence being provided by the Examiner on this point. For this reason, the Examiner's rejection fails to present a prima facie case of obviousness, and the rejection must be withdrawn.

The Examiner attempts to justify the rejection by theorizing that one of ordinary skill in the art would have experimented or tried to provide another V shaped portion on a straight portion of Fukumoto. But the question remains, why would one of ordinary skill in the art have done so? There is no recognition in the art, and no cited reason, to make any such experimentation. The Examiner has cited no evidence to indicate that those of skill in the art would have had a reason. Even under KSR, the office is still required to provide evidence on the issue of obviousness, i.e. there still must be a reason to make a modification of the prior art. There is no evidence as to any reason to modify Fukumoto outside of Applicant's own specification. It is only applicants that have recognized the reason to use a common punch for the two groups.

The Examiner further attempts to justify the rejection by saying that it would have been obvious to try different arrangements. But again, why? The prior art is not recognizing a problem with the prior art. There is no evidence to indicate a reason for a modification. The Examiner's conclusion is based on no evidence of record.

The Examiner further attempts to justify the rejection by saying that the rearranging of parts of an invention involves only routine skill in the art, citing In re Japikse. But this generality refers to situations where the rearrangement makes no functional difference. With the present invention, the number of parts are being reduced, the arrangement is being simplified, and the operation is being changed from that of Fukumoto. This is not merely a rearrangement of parts.

The Examiner then says that the change is an obvious matter of design choice. But again, saying something is a design choice is saying that it does not functionally matter, the one is as good as the other. This is not the case here. Saying something is a design choice is a conclusion, it is not evidence.

The Examiner further states that the claim would have been obvious because a person of ordinary skill has good reason to pursue the known options within technical grasp. This statement even more clearly evidences the impropriety of the rejection because (1) there is no evidence on any reason to pursue this type of change in the prior art, (2) there is no evidence that

the applicant's invention is a known option, or (3) that it is within the technical grasp of those of skill in the art.

Applicant's have presented their invention from the outset distinguishing over Fukumoto, clearly stating what they believe to be the inventive contribution. The Examiner may believe that this contribution is obvious, but this cannot be established by the Examiner simply stating that it is obvious, which is what the rejection does. The Examiner is required to cite evidence, which the Examiner has not done. As such, the rejection fails to present a prima facie case of obviousness and must be withdrawn.

#### **Claim Amendments**

By the above amendments, claim 15 has been limited to the aspects of prior claim 20. This has been done in an attempt more speedily obtain the allowance of the application, even though such amendment is clearly not necessary to distinguish over the prior art.

Thus, claim 15 now further requires that the first movable range (in which the reciprocating member is moved for punching with the first group of punches) is a range in which the reciprocating member has moved when it has advanced by one step in one direction of reciprocation from a home position with respect to a main frame that supports the reciprocating member. Claim 15 now also requires that the second movable range (in which the reciprocating member is moved for punching with the second group of punches) is a range in which the reciprocating member has moved when it has advanced by another step in the one direction of reciprocation. Fukumoto has no such operation.

The operation of Fukumoto can be readily appreciated from looking at Fig. 1. Movement of the reciprocating member in this embodiment to the left would mean that the two punches on either side of the center punch would be lowered. Movement to the right would mean that the two most outside punches, and the center punch, would be lowered. Thus, either two hole punching or three hole punching could be accomplished. However, there are no punches or cam surfaces used in common. See also Figs. 5 and 6. Clearly, there is also no first and second

movable ranges of a reciprocating member that are in steps in the same direction as now required.

Accordingly, it is clear that claim 15 defines over Fukumoto, and indication of such is respectfully requested. In view of the above it is respectfully submitted that claim 15 and its dependent claims are in condition for allowance, and indication of such is further requested.

In view of the above amendments and remarks, it is submitted that the present application is now in condition for allowance, and the Examiner is requested to pass the case to issue. If the Examiner should have any comments or suggestions to help speed the prosecution of this application, the Examiner is requested to contact Applicants' undersigned representative.

Respectfully submitted,

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